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# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

555255-012530

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on sep. 18, 2008

Signature Debra Pejau

Typed or printed name Debra Pejau

Application Number

10/730,682

Filed

12/08/2003

First Named Inventor

Gerhard D. Klassen

Art Unit

2154

Examiner

Haresh N. Patel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

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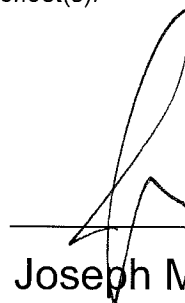
☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record. 47,919  
Registration number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Signature

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Typed or printed name

216-586-7506

Telephone number

9/18/8

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Klassen, et al.  
Title : MULTI-COMMUNITY INSTANT  
MESSAGING SYSTEM AND DEVICE  
Application No. : 10/730,682  
Filed : December 8, 2003  
Confirmation No. : 5722  
Group Art Unit : 2154  
Examiner : Haresh N. Patel

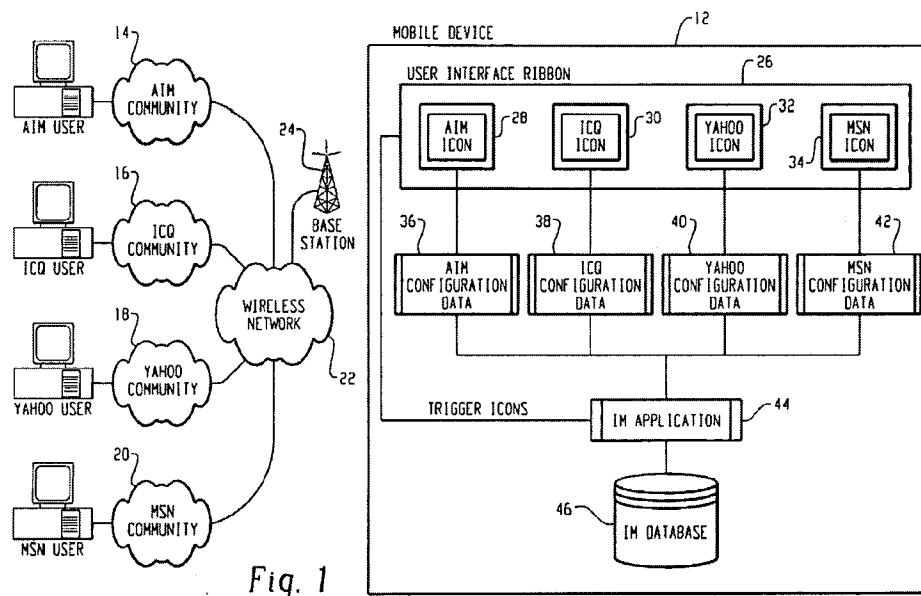
**REQUEST FOR PRE-APPEAL BRIEF CONFERENCE**

Dear Sirs:

The Examiner has issued a Final Rejection of the pending claims. The patent owner hereby requests review of the Final Rejection prior to filing an appeal brief for the reasons set forth below. Any fees due should be charged to Jones Day Deposit Account No. 501432, ref: 555255-012530.

## I. Summary of the Claimed Subject Matter

The instant application includes three independent claims, claims 1, 18 and 19. Each of the independent claims recite a user interface for displaying a plurality of service-specific icons that provide an identification of one of a plurality of instant messaging services. Upon selecting one of the service-specific instant messaging icons, a common instant messaging application is configured for use as a service-specific instant messaging application using one of a plurality of configurations data files that is associated with the selected service-specific instant messaging icon. An example of these claimed features is shown in Fig. 1, which is reproduced below for convenience.



In the example depicted in Fig. 1, four service-specific instant messaging icons 29, 30, 32, 34 are included in a user interface ribbon 26. When the user selects one of these icons 29, 30, 32, 34, a common instant messaging application program 44 is executed by the device processor. The instant messaging application is configured for the particular instant messaging community specified by the selected icon using a service-specific configuration data file 36, 38, 40, 42. The configuration data file causes the common instant messaging application program 44 to operate and appear like a specific application for

the selected instant messaging service. (See, Application Publication No. 2005/0138124, paragraph 0017).

**II. The final office action clearly fails to establish a prima facie rejection and must be withdrawn.**

The pending claims are rejected under 35 U.S.C. § 102(e) as being anticipated by each of Mitchell (U.S. 2005/0050151) and Papanikolaou (U.S. 2004/0049589). The rejections are improper and must be withdrawn because the Examiner has clearly failed to meet his burden of showing anticipation of each of the recited claim elements. The office action makes no real attempt to demonstrate how either of the cited references allegedly relate to any elements of the claims under rejection. Instead, the Examiner merely cites to whole pages of the references, without providing any explanation or any attempt to show how even a single element of the claims corresponds to anything in the cited references. For example, in the rejection of claim 1 over the Mitchell reference, the Examiner cites to the entirety of pages 4 and 6 of the reference, without any explanation. This type of cursory rejection is clearly improper under 37 C.F.R. § 1.104(b) *Completeness of Examiner's Action* which states "the examiner's action will be complete as to all matters..." *See also*, MPEP 2131.01 ("To anticipate a claim, the reference must teach every element of the claim.") Further, the patent owner cannot reasonably be expected to respond to such an incomplete rejection, particularly when the cited references have no apparent relevance to the language of the claims. For this reason alone, the patent owner submits that the rejections under 35 U.S.C. § 102(e) are improper and must be withdrawn.

**III. A proper rejection could not be established because the cited references are irrelevant to the claims of the instant application.**

The patent owner submits that proper rejections under 35 U.S.C. § 102(e) could not be established by the Examiner because the cited references have no apparent relevance to the language of the claims. The Mitchell reference describes an instant messaging architecture that manages communications with multiple users based on event tasks. Page 4 of the Mitchell reference, which is repeatedly cited in the final office action, describes the network architecture for the automated instant

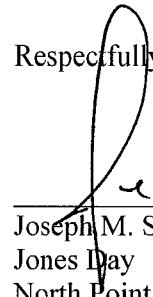
messaging system shown in Fig. 2. The description of Fig. 2 on page 4 of the Mitchell reference explains how the automated instant messaging system controls the flow of information through the network architecture. However, it is unclear how any of this purportedly relates to the language of the claims.

For instance, what part of Mitchell's network architecture provides a user interface for displaying a plurality of service-specific icons that identify different instant messaging services? There are no icons of any sort described on page 4 or shown in Fig. 2 of Mitchell. The Mitchell reference also does not appear to describe anything that could reasonably be characterized as a plurality of configuration data files that are each associated with a different service-specific icon and that cause a common instant messaging application to be configured for use as a service-specific instant messaging application. The patent owner therefore submits that a proper rejection under 35 U.S.C. § 102(e) could not be established based on the Mitchell reference and that the rejections should be withdrawn.

The cited Papanikolaou reference is even more irrelevant to the claims of the instant application. Papanikolaou describes an Internet portal structure for providing end user access to on-line services and applications. It does not have anything to do with instant messaging or with user interface icons. In fact, the term "instant messaging" appears only once in the entire Papanikolaou reference. (*See*, Patent Publication No. 2004/0049589, paragraph 006.) The word "icon" does not appear at all. In an attempt to address these obvious deficiencies in the Papanikolaou reference, the Examiner proposes at page 13 of the Final Office action that "when reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection." The patent owner submits that the Papanikolaou reference is so wholly unrelated to the claims of the instant application that the artisan could not reasonably infer any relationship between the two. Further, the Examiner has made no attempt to explain what the skilled artisan would purportedly infer from the reference. The rejection is therefore clearly improper and must be withdrawn.

For at least the above reasons, the patent owner respectfully submits that the rejections of the pending claims clearly fail to establish a prima facie rejection under 35 U.S.C. § 102(e). It is therefore requested that the rejections be withdrawn and that the application be passed to issue.

Respectfully submitted,



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